

## REMARKS

Claims 1-25 are currently pending in the application. Claims 1-25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0147704 to Borchers ("Borchers") in view of U.S. Patent No. 5,089,985 to Chang ("Chang") and U.S. Patent No. 6,006,218 to Breese *et al.* ("Breese").

### **Interview Summary:**

The assistance provided by Examiner Naeem Haq during a telephone conference with Applicant's representative, Daren C. Davis, on 13 April 2005 is acknowledged with appreciation. In that conference, Applicant's representative noted that the Interview Summary appended to the present Office Action requires Applicant to provide a written record of the substance of the interview of 4 January 2005. The interview, however, was conducted with a practitioner that is no longer representing Applicant. Examiner Haq indicated that a written reply by Applicant as to the substance of the interview is required only if Applicant disagrees with the substance of the interview, as provided by the Office. Applicant hereby reiterates Applicant's agreement as set forth in the Interview Summary. Accordingly, it is believed no presentation by Applicant of the substance of the interview of 4 January 2005 is required.

### **Rejection Under 35 U.S.C. § 103(a):**

As indicated above, claims 1-25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Borchers in view of Chang and Breese. As indicated in Applicant's "Response Pursuant to 37 C.F.R. § 1.111", filed on 6 October 2004 in response to the Office Action dated 6 July 2004, Applicant reserves the right to antedate Borchers in a future Response or on Appeal.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally

available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Claim 1 recites "communicate one or more sorting parameters to the seller databases, the sorting parameters directing each seller database to sort the local search results generated at each seller database in response to the search query." The Office acknowledges on the record that Borchers fails to disclose this limitation. The Office alleges that Chang teaches the above limitation and further alleges that one of ordinary skill in the art would have been motivated to incorporate the teachings of Chang into the invention of Borchers "in order to reduce the total sort time as taught by Chang (Abstract lines 16-19; column 2, lines 20-62)" (Detailed Action, p. 4, ll. 20-21).

The passage in Chang cited by the Office, however, fails to provide any motivation to make such a modification to Borchers. Chang teaches, in the passage cited by the Office (col. 2, ll. 20-62), that sort functions can be accelerated by storing at least part of the data being sorted in memory of the CPU, rather than storing the data to a disk or hard file. If one of ordinary skill in the art were to incorporate Chang's teachings into Borchers' invention, in light of the above-referenced passage, the result would be to modify Borchers' invention to store at least part of the search results in memory during the sorting process. One of ordinary skill in the art, however, would not be motivated to move the sorting process from Borchers' centralized search location or to provide any non-centralized, "pre-sort" process on the disparate file systems. "The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Gordon*, 221 U.S.P.Q. (BNA) 1125, 1127 (Fed. Cir. 1984); *In re Brouwer*, 37 U.S.P.Q.2d (BNA) 1663, 1666 (Fed. Cir. 1995); *In re Ochiai*, 37 U.S.P.Q.2d (BNA) 1127, 1131 (Fed. Cir. 1995). It is respectfully submitted that any attempt to assert that the cited references, either singly or in combination, disclose or suggest the claimed invention as a whole is necessarily based on an improper use of hindsight using Applicant's disclosure as a roadmap.

Moreover, Applicant maintains that the combination of Borchers, Chang, and Breese is improper. A reference can be asserted against the claimed invention under §103 only if (1) it is within Applicant's field of endeavor, or (2) is reasonably pertinent to the

problem facing Applicant even though not within Applicant's field of endeavor. *In re Clay*, 23 U.S.P.Q.2d (BNA) 1058, 1060 (Fed. Cir. 1992).

Chang relates to a system and method of sorting data in a relational database (col. 1, ll. 10-12) not to distributed processing of search results in an electronic commerce system (p. 1, ll. 4-5, of Applicant's Specification), as does the present invention. Thus, Chang is not within Applicant's field of endeavor and can be within the scope and content of the prior art only if it is "reasonably pertinent" to Applicant's invention. *In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992) (reversing Board holding of obviousness).

Nor is Chang reasonably pertinent to Applicant's invention. Applicant's invention is directed to decreasing the processing power required to sort search results and to decreasing the amount of data transmitted in the search results (p. 3, l. 29, through p. 4, l. 5, of Applicant's Specification). Chang, however, is directed to decreasing the number of disk or hard file input/output operations needed during a sort operation, using the passage cited by the Office (col. 2, ll. 20-62). Thus, even though Chang concerns sorting, it is not reasonably pertinent to Applicant's invention.

The discussion in *Clay* is pertinent to the present case. In addressing the first part of the test for analogous art, the Federal Circuit reasoned:

*The PTO argues that [the reference] and [Applicant's] inventions are part of a common endeavor—"maximizing withdrawal of petroleum stored in petroleum reservoirs." However, [the reference] cannot be considered to be within [Applicant's] field of endeavor merely because both relate to the petroleum industry. ...[Applicant's] field of endeavor is the storage of refined liquid hydrocarbons. The field of endeavor of the [reference], on the other hand, is the extraction of crude petroleum. The Board clearly erred in considering [the reference] to be within the same field of endeavor as [Applicant's].*

*Clay*, 23 U.S.P.Q.2d (BNA) at 1060. This reasoning reads directly on the present case with only slight modification for the technologies involved. With respect to the second part of the test, the Federal Circuit, after a discussion of the two inventions, held:

*A person having ordinary skill in the art would not reasonably have expected to solve the problem of dead volume in tanks for storing refined petroleum by considering a reference dealing with plugging underground*

*formation anomalies. The Board's finding to the contrary is clearly erroneous.*

Clay, 23 U.S.P.Q.2d (BNA) at 1061. Again, with some modification for the involved technologies, the reasoning applies directly to the present case. Chang, however, does not deal with the problem of decreasing the processing power required to sort search results and decreasing the amount of data transmitted in the search results, as does the present invention. Thus, Chang is not "reasonably pertinent" to Applicant's invention and is, therefore, outside the scope and content of the prior art.

Accordingly, independent claim 1 and claims 2-7, which depend from claim 1, are allowable over the cited references. Furthermore, claims 8-25 are allowable over the cited references for at least the same reasons set forth above concerning claim 1. It is, therefore, respectfully requested that the rejection of claims 1-25 under 35 U.S.C. § 103(a), as being unpatentable over Borchers in view of Chang and Breese, be reconsidered and withdrawn.

Note that Applicant has merely discussed example distinctions from the various references cited by the Office. Other distinctions may exist and Applicant reserves the right to discuss these additional distinctions in a future Response or on Appeal. By not responding to the additional statements made by the Examiner, Applicant does not acquiesce to the Examiner's additional statements. The remarks provided above are sufficient to overcome the Office's rejections.

#### **The Legal Standard for Obviousness Rejections Under 35 U.S.C. § 103:**

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the

prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

## CONCLUSION

The Applicant submits that all of the Examiner's rejections are hereby traversed and overcome. The Applicant respectfully submits that the Examiner has not shown by clear and convincing evidence that the claimed invention would have been obvious to one of ordinary skill in the art at the time of the invention in light of Borchers, Chang, and Breese. For the reasons set forth herein, the Applicant submits that claims 1-25 are in condition for allowance, and respectfully requests that claims 1-25 be allowed.

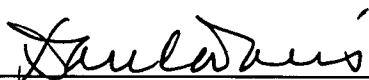
No fees are deemed to be necessary; however, the undersigned hereby authorizes the Commissioner to charge any fees which may be required, or credit any overpayments, to Deposit Account No. **500777**. Should the balance in this deposit account be insufficient to fund the required fees, the undersigned hereby authorizes the Commissioner to alternatively charge any additional fees that may be required to Deposit Account No. **502806**.

**Please link this application to Customer No. 38441 so that its status may be checked via the PAIR System.**

Respectfully submitted,

13 APRIL 2005

Date

  
James E. Walton, Reg. No. 47,245  
Michael Alford, Reg. No. 48,707  
Daren C. Davis, Reg. No. 38,425  
Brian E. Harris, Reg. No. 48,383

Law Offices of James E. Walton, P.L.L.C.  
1169 N. Burleson Blvd., Suite 107-328  
Burleson, Texas 76028  
(817) 447-9955 (voice)  
(817) 447-9954 (facsimile)

jim@waltonpllc.com (e-mail)

**CUSTOMER NO. 38441**

**ATTORNEYS AND AGENTS FOR APPLICANT**